

Attorney Docket No.: **BIS-043 (BI-0004US)**  
Inventor: **Simons and Gao**  
Serial No.: **09/276,868**  
Filing Date: **March 26, 1999**  
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**REMARKS**

Claims 11 and 13-15 are pending in the instant application. Claims 11 and 13-15 have been rejected. Claims 11 and 13-15 have been canceled. Claim 16 has been added. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

**I. Rejection of Claims Under 35 U.S.C. §112**

Claims 11 and 13-15 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is suggested that while the specification teaches PR-39 derived oligopeptides represented as PR-15, PR-11 and PR-8, it does not disclose that active peptides are not substantially greater than 11 amino acid residues or are less than 8 amino acid residues in length, nor describes any particular structure to function/activity relationship for the claimed species.

Claims 11, 13 and 14 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, it is suggested that the phrase "a pharmacologically active peptide which is not substantially greater than 11 amino acid residues in length" renders the claim indefinite as it is not clear what is the metes and bounds for the number or residues in the active peptide.

Applicants respectfully disagree with these rejections.

Applicants have clearly provided the distinguishing characteristics of the claimed oligopeptides both structurally

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(i.e., being 11 or less than 8 amino acid residues and having an N-terminal amino acid sequence of Arg-Arg-Arg) and functionally (i.e., selectively altering the proteolytic degradation activity of proteasomes and interacting in-situ with at least the  $\alpha$ 7 subunit of proteasomes) to convey to one skilled in the art at the time of filing of the present application that Applicants were in possession of that which is claimed. However, in an earnest effort to facilitate the prosecution of this application, Applicants have canceled pending claims 11 and 13-15 without prejudice reserving the right to file continuing applications on the canceled subject matter, and added new claim 16, drawn to a PR-39 derived oligopeptide consisting of the amino acid sequence Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr (SEQ ID NO:5) or Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr-Leu-Pro-Arg (SEQ ID NO:4). Support for this amendment is found in canceled claims 13 and 14. In so far as Applicants have conveyed the instant oligopeptides in clear and concise terms, it is respectfully requested that the rejections under 35 U.S.C. 112 be reconsidered and withdrawn.

## **II. Conclusion**

The Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

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Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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